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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/813,688	03/19/2001	James West	251208-1010	3445

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EXAMINER

NGUYEN, TAN D

ART UNIT

PAPER NUMBER

3629

DATE MAILED: 08/01/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/813,688

Applicant(s)

WEST ET AL.

Examiner

Tan Dean Nguyen

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 March 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 17-20 and 1-9 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

In order for the claimed invention to be statutory subject matter, the claimed invention must fall within one of the statutory classes of invention as set forth in § 101 (i.e. a process, machine, manufacture, or composition of matter). In the present case, claims 17-20, 1-9 are directed to a "method for selling an article of jewelry (or ring)", which is not within one of the classes of invention set forth in § 101.

The process for "selling an article of jewelry (or ring)" comprising the steps of providing a display, delivering the article of jewelry in a box, and providing a presentation folder are merely an abstract idea and do not produce a useful, tangible, concrete results.

The process for "selling an article of jewelry (or ring)" comprising the steps of providing a display, delivering the article of jewelry in a box, and providing a presentation folder are merely an abstract idea and does not involve any computer or structural means to carry out any functions and therefore are found to be non-statutory subject matter.

Claim Rejections - 35 USC § 112

3. Claims 17-20, 1-9, 10-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 17 and 1 directs to a method for selling an article of jewelry but contains ✓ ok no steps involved with exchanging or paying the article with money or its equivalent or making a sale, etc., in the body of the claims.

In claim 17, the phrase "the box containing at least one love story" is not clear? Is ✓ the love story printed on the box or it's a love story letter or pamphlet or card? It's not ✓ clear the relationship of the last step "providing a presentation folder" to the remaining ✓ claim body above? Where is the folder located at? _____

In claim 1, It's not clear the relationship of the last step "providing a presentation _____ folder" to the remaining claim body above? Where is the folder located at? _____

In claim 10, it's not clear what is the form of the "love story" with respect to the ✓ display? Is it printed on the display? In claim 10, line 3, the term "it" is vague because ✓ It's not clear what "it" represents.

Claim 11, the phrase "the method as defined in claim 10" is vague because claim ✓ 10 is an apparatus claim.

4. Claim 10 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. See

MPEP § 2172.01. The omitted structural cooperative relationships are: folder to the box.

Claim Rejections - 35 USC § 103

5. Claims 17-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dialog11027578 of May 13, 2000.

DIALOG 11027578 discloses a method for enhancing the sell value of an article of jewelry comprising: providing a display in close proximity connections with the jewelry article, delivering the article in a box and providing a folder (cards) (see page 5).

DIALOG 11027578 repeatedly discloses the designing of the heart shaped in all of the jewelry pieces and since heart is normally associated with love theme, it would have been obvious modify the box or other displaying items of DIALOG 11027578 to include love story theme.

As for claim 18, this is taught on page 5 of DIALOG 11027578.

6. Claims 19-20, 1-9, 10-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over DIALOG 11027578 in view of DIALOG 13117692.

As for claims 19-20, DIALOG 13117692 is cited to teach the step of providing personal insignia symbols or words on the jewelry article to increase its personal value and price or luxury (see page 3). It would have been obvious to modify the process of DIALOG 11027578 to provide personal or desired insignia with and on the jewelry article as taught by DIALOG 13117692 to increase its hidden luxury. The selection of the love theme or heart on the insignia would have been obvious in view of the general teaching of using heart shape or love by DIALOG 11027578 above.

As for claims 1-4, they are rejected for the same reason set forth in claims 19-20 above. As for claim 5, DIALOG 13117692 discloses the inscribing on the gift box words of Burns, however, the selection of words related with love or romance would have been obvious. As for claim 6, this is taught in DIALOG 13117692 page 3, 1st paragraph. As for claims 7-9, the selections of the locations of the insignias on the ring would have been obvious as mere personal choice. As for claims 10-15, they are rejected for the same reason set forth in method claims 1-9 but with respect to a jewelry assembly or elements to carry out the process of claims 1-9.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

1) US Patent: US 5,810,162 discloses a jewelry box. US 5,913,417 discloses a jewelry pads having recesses, projections and plugs for holding jewelry items.

2) De 29808455U discloses a combined gift article and toy has heart with round opening to receive rotary disc with letter which is selectively covered

3) Dialog 13117692 discloses jewel in the crown.

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8. Telephone inquiries regarding the status of applications or other general questions, by persons entitled to the information, should be directed to the group clerical personnel and not to the examiner. As the official records and applications are located in the clerical section of the examining Tech Center, the clerical personnel can readily provide status information without contacting the examiner. See MPEP 203.08. The Tech Center clerical receptionist number is (703) 308-1113.

In receiving an Office Action, it becomes apparent that certain documents are missing, e. g. copies of references, Forms PTO 1449, PTO-892, etc., requests for copies should be directed to Tech Center 3600 Customer Service at (703) 306-5771, or e-mail CustomerService3600@uspto.gov .

Any inquiry concerning the merits of the examination of the application should be directed to Dean Tan Nguyen at telephone number (703) 308-2053. My work schedule is normally Monday through Friday from 7:00 am through 4:30 pm.

Should I be unavailable during my normal working hours, my supervisor John Weiss may be reached at (703) 308-2702. The FAX phone numbers for formal communications concerning this application are (703) 305-7687. Informal communications may be made, following a telephone call to the examiner, by an informal FAX number to be given.

Other possibly helpful telephone numbers are:

Allowed Files & Publication	(703) 305-8322
Assignment Branch	(703) 308-9287
Certificates of Correction	(703) 305-8309
Drawing Corrections/Draftsman	(703) 305-8404/ 8335
Fee Questions	(703) 305-5125
Intellectual Property Questions	(703) 305-8217
Petitions/Special Programs	(703) 305-9282
Terminal Disclaimers	(703) 305-8408
Information Help Line	1-800-786-9199

dtn
July 28, 2003


DEAN T. NGUYEN
PRIMARY EXAMINER